

Appl. No. 09/997,915
Appeal Brief dated 03/01/2007
Reply to Office Action of 12/01/2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Application of:	:
Bhupesh Gupta	:
	: Before the Examiner:
Serial No: 09/997,915	: Gautam Sain
	:
Filed: 11/29/2001	: Group Art Unit: 2176
	:
Title: APPARATUS AND METHOD	: Confirmation No.: 6707
OF ORGANIZING BOOKMARKED	:
WEB PAGES INTO CATEGORIES	:

APPELLANTS' BRIEF UNDER 37 C.F.R. 41.37

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In a Final Office Action dated August 25, 2005, the Examiner rejected the claims in this Application under 35 U.S.C. §102(b) as being anticipated by Burke. On December 11, 2005, Applicants appealed this decision.

In an Office Action dated February 23, 2006, the Examiner re-opened the Application's prosecution. In that Office Action, the Examiner rejected the claims under 35 U.S.C. §103(a) as being unpatentable over Burke in view of Li et al. Applicants reinstated the Appeal on May 22, 2006.

The Examiner, again, re-opened prosecution of the Application in an Office Action dated December 01, 2006. In this Office Action, the Examiner rejected the claims (Claims 1 – 33) under 35 U.S.C. §102(e) as being anticipated by Khan. Again, Appellants are reinstating the appeal.

This Appeal Brief is submitted pursuant to a concurrently filed Notice of Appeal under 37 CFR §41.31.

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BRIEF FOR APPLICANTS - APPELLANTS

(i)

Real Party in Interest

The real party in interest is International Business Machines Corporation (IBM), the assignee.

(ii)

Related Appeals and Interferences

There are no other appeals or interferences known to appellants, appellants' representative or assignee, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(iii)

Status of Claims

Claims 1 – 33 are rejected under 35 U.S.C. §102(e) as being anticipated by Khan. All the rejected claims are being appealed.

(iv)

Status of Amendment

All amendments have been entered.

(v)

Summary of Claimed Subject Matter

The invention, as claimed in Claim 1, provides a computer implemented method of categorizing bookmarked Web pages in a bookmark folder. The computer implemented method comprises determining whether a Web page to be bookmarked has been assigned a category on a server; downloading the category if the Web page has been assigned a category; creating a sub-folder in the bookmark folder with the category as a name; and storing a bookmark to the Web page into the sub-folder (see page 12, lines 13 to 32, bookmark button 815

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of Fig. 8, page 15, lines 16 to 24 and page 15, line 27 to page 16, line 9 as well as Fig. 9). The step plus functions are the steps outlined on page 15, line 25 to page 16, line 9 and in Fig. 9.

The invention, as claimed in Claim 9, provides a computer program product on a computer readable medium for categorizing bookmarked Web pages in a bookmark folder. The computer program product comprises code means for determining whether a Web page to be bookmarked has been assigned a category on a server; code means for downloading the category if the Web page has been assigned a category; code means for creating a sub-folder in the bookmark folder with the category as a name; and code means for storing a bookmark to the Web page into the sub-folder (see page 12, lines 13 to 32, bookmark button 815 of Fig. 8, page 15, lines 16 to 24 and page 15, line 27 to page 16, line 9 as well as Fig. 9). The code means plus functions are the steps outlined on page 15, line 25 to page 16, line 9 and in Fig. 9.

The invention, as claimed in Claim 17, provides a computer implemented apparatus for categorizing bookmarked Web pages in a bookmark folder. The computer implemented apparatus comprises means for determining whether a Web page to be bookmarked has been assigned a category on a server; means for downloading the category if the Web page has been assigned a category; means for creating a sub-folder in the bookmark folder with the category as a name; and means for storing a bookmark to the Web page into the sub-folder (see page 12, lines 13 to 32, bookmark button 815 of Fig. 8, page 15, lines 16 to 24 and page 15, line 27 to page 16, line 9 as well as Fig. 9). The means plus functions are the steps outlined on page 15, line 25 to page 16, line 9 and in Fig. 9 in conjunction with processor 202, 204 of Fig. 2 or processor 302 of Fig. 3.

The invention, as claimed in Claim 25, provides a computer system for categorizing bookmarked Web pages in a bookmark folder. The computer system comprises at least one memory device (i.e., local memory 209, hard disk 232 of Fig. 2, main memory 304, memory 324, disk 326, tape 328 or CD-ROM 330 of Fig. 3) for storing code data; and at least one processor (i.e., with
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processor 202, 204 of Fig. 2 or processor 302 of Fig. 3) for processing the code data to determine whether a Web page to be bookmarked has been assigned a category on a server, to download the category if the Web page has been assigned a category, to create a sub-folder in the bookmark folder with the category as a name and to store a bookmark to the Web page into the sub-folder (see page 12, lines 13 to 32, bookmark button 815 of Fig. 8, page 15, lines 16 to 24 and page 15, line 27 to page 16, line 9 as well as Fig. 9).

The invention, as claimed in Claim 33, provides a computer implemented method of categorizing bookmarked Web pages in a bookmark folder on a local computer system. The computer implemented method comprises the steps of determining whether a Web page is to be bookmarked on the local computer system; determining, if the Web page is to be bookmarked, whether the Web page has been assigned a category on a remote computer system; downloading the category if the Web page has been assigned a category; determining whether the downloaded category already exists as a name of a sub-folder in the bookmark sub-folder on the local computer system; storing, if the downloaded category already exists as a name of a sub-folder in the bookmark sub-folder on the local computer system, a bookmark to the Web page into the sub-folder; creating, if the downloaded category does not already exist as a name of a sub-folder in the bookmark sub-folder on the local computer system, a sub-folder in the bookmark folder on the local computer system with the downloaded category as a name for the sub-folder; and storing the bookmark to the Web page into the created sub-folder (see page 12, lines 13 to 32, bookmark button 815 of Fig. 8, page 15, lines 16 to 24 and page 15, line 27 to page 16, line 9 as well as Fig. 9). The step plus functions are the steps outlined on page 15, line 25 to page 16, line 9 and in Fig. 9.

(vi)

Grounds of Rejection to be Reviewed on Appeal

**Whether Claims 1 - 33 were properly rejected under 35 U.S.C. §102(e) as
being anticipated by Khan**

(vii)

Arguments

**Whether Claims 1 - 33 were properly rejected under 35 U.S.C. §102(e) as
being anticipated by Khan**

Claims 19, 17, 25 and 33

Khan purports to teach a method for dynamically generating an Internet search directory based on prioritized server-sided user bookmarks. Specifically, Khan teaches that a user at a client system may create a bookmark folder on a server. Bookmarks from a bookmark folder on the client system may be uploaded to the server to fill up the bookmark folder. Instead of or in addition to uploading bookmarks from the user's bookmark folder on the client system, the user may, while browsing the Internet, bookmark pages directly into the bookmark folder on the server or type-in URLs of Web pages directly into the bookmark folder on the server.

In any event, the bookmarks being stored in the bookmark folder on the server may be automatically put in a category in the bookmark folder or the user may enter them into a particular category in the bookmark folder on the server. When a bookmark is put into a category, automatically or otherwise, a search is undertaken to determine whether the bookmark has already been stored in a category in the bookmark folder. If so, the user is notified for further actions; otherwise, the bookmark is stored in the category.

However, nowhere in the disclosure does Khan teach, show or so much as suggest the steps of ***downloading a category if*** it has been determined that a Web page to be bookmarked has been assigned a category on a server; ***creating a sub-folder in the bookmark folder with the category as a name;***

and ***storing a bookmark to the Web page into the sub-folder*** as claimed in the invention.

The Examiner stated that:

the downloading step is broadly interpreted to include a user's knowledge of a theme and/or subject matter and the user manually creating a subcategory as the downloading is complete from user's knowledge to the directory manually on the computer system. Khan teaches both, manual or automatic categorization of bookmarks (col. 11, lines 58 – 66).

Firstly, it is a well settled law that in considering a Section 102 rejection, all the elements of the claimed invention must be disclosed in a single item of prior art in the form literally defined in the claim. *Jamesbury Corp. v. Litton Indus. Products*, 756 F.2d 1556, 225 USPQ 253 (Fed. Cir. 1985); *Atlas Powder Co. v. Dupont*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); *American Hospital Supply v. Travenol Labs.*, 745 F.2d 1, 223 USPQ 577 (Fed. Cir. 1984).

Since the law requires that the single item of prior art disclose all the elements of the claimed invention in the form literally defined in the claim, the Examiner is not allowed to make any interpretation of the claimed invention. The single item of prior art either discloses all the elements of the claimed invention or not.

In this case, Khan does not disclose all the elements of the claimed invention in the form literally defined in the claim since the Examiner has to interpret the invention to make it fit the disclosure of Khan. Hence, Appellants submit that the step of **downloading the category if the Web page has been assigned a category** is not disclosed by Khan.

Secondly, the step of "DOWNLOADING," as used in the present Application and as is conventionally defined, is the step of moving a copy of a file from a server system, for example, to a client computer system. Downloading has never meant, broadly or otherwise, to include a user's knowledge of a theme

and/or subject matter and the user manually creating a subcategory as the downloading is complete from user's knowledge to the directory manually on the computer system.

Since, Khan does not disclose the step of downloading as used in the present Application and as is conventionally defined, Appellants submit that Khan does not teach the claimed invention.

Thirdly, Appellants do not understand the statement made by the Examiner regarding the step of downloading. Appellants kindly request that the Examiner elaborate on that statement.

Appellants note that the Examiner did not bother showing where in the disclosure Khan teaches the step of ***creating a sub-folder in the bookmark folder with the category as a name***; and ***storing a bookmark to the Web page into the sub-folder***.

Claims 6, 14, 22 and 30

Claims 6, 14, 22 and 30 includes the limitations of "wherein after the Web page has been assigned a category, the category and the URL of the Web page are downloaded wherein the downloaded category is used as a name to a sub-folder into which the bookmark to the Web page is to be moved and the URL is used to differentiate the Web page from other Web pages that may be in the default sub-folder."

Firstly, and as mentioned above, Khan does not teach the step of downloading categories.

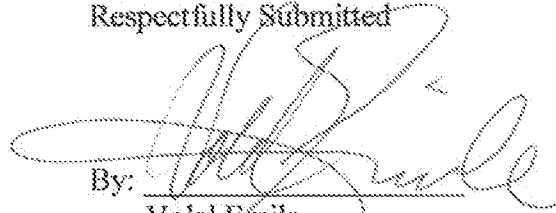
Secondly, Khan does not teach the step of downloading URLs of Web pages to be bookmarked. Rather, Khan teaches the step of uploading bookmarks and presumably URLs of page to be bookmarked.

Consequently, Khan does not teach the claimed limitations of Claims 6, 14, 22 and 30.

Based on the foregoing, Appellants kindly request withdrawal of the rejection and passage to issue of the claims.

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Respectfully Submitted

A large, stylized handwritten signature in black ink, appearing to read 'Volel Emile', is written over a horizontal dotted line.

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(vii)

Claims Appendix

1. (Previously presented) A computer implemented method of categorizing bookmarked Web pages in a bookmark folder comprising the steps of:

determining whether a Web page to be bookmarked has been assigned a category on a server;

downloading the category if the Web page has been assigned a category;

creating a sub-folder in the bookmark folder with the category as a name;
and

storing a bookmark to the Web page into the sub-folder.
2. (Previously presented) The computer implemented method of Claim 1 further including the step of determining whether there already exists a sub-folder with the category as a name before creating the sub-folder.
3. (Previously presented) The computer implemented method of Claim 2 wherein if there already exists a sub-folder with the category as a name, the bookmark to the Web page is stored into the already existed sub-folder and the sub-folder is not created.
4. (Previously presented) The computer implemented method of Claim 1 wherein if the Web page has not been assigned a category, the Web page is stored into a default sub-folder.

5. (Previously presented) The computer implemented method of Claim 4 wherein if the Web page has not been assigned a category, a note is sent to an administrator of the server requesting that the Web page be assigned a category.
6. (Previously presented) The computer implemented method of Claim 5 wherein after the Web page has been assigned a category, the category and the URL of the Web page are downloaded wherein the downloaded category is used as a name to a sub-folder into which the bookmark to the Web page is to be moved and the URL is used to differentiate the Web page from other Web pages that may be in the default sub-folder.
7. (Previously presented) The computer implemented method of Claim 6 further including the step of determining whether there already exists a sub-folder with the category as a name in the bookmark folder before creating the sub-folder.
8. (Previously presented) The computer implemented method of Claim 7 wherein if there already exists a sub-folder with the category as a name, a sub-folder is not created and the bookmark to the Web page is moved into the already existed sub-folder.
9. (Previously presented) A computer program product on a computer readable medium for categorizing bookmarked Web pages in a bookmark folder comprising:

code means for determining whether a Web page to be bookmarked has been assigned a category on a server;

code means for downloading the category if the Web page has been assigned a category;

code means for creating a sub-folder in the bookmark folder with the category as a name; and

code means for storing a bookmark to the Web page into the sub-folder.

10. (Original) The computer program product of Claim 9 further including code means for determining whether there already exists a sub-folder with the category as a name before creating the sub-folder.
11. (Original) The computer program product of Claim 10 wherein if there already exists a sub-folder with the category as a name, the bookmark to the Web page is stored into the already existed sub-folder and the sub-folder is not created.
12. (Original) The computer program product of Claim 9 wherein if the Web page has not been assigned a category, the bookmark to the Web page is stored into a default sub-folder.
13. (Original) The computer program product of Claim 12 wherein if the Web page has not been assigned a category, a note is sent to an administrator of the server requesting that the Web page be assigned a category.
14. (Original) The computer program product of Claim 13 wherein after the Web page has been assigned a category, the category and the URL of the Web page are downloaded wherein the downloaded category is used as a name to a sub-folder into which the bookmark to the Web page is to be

moved and the URL is used to differentiate the Web page from other Web pages that may be in the default sub-folder.

15. (Original) The computer program product of Claim 14 further including code means for determining whether there already exists a sub-folder with the category as a name in the bookmark folder before creating the sub-folder.

16. (Original) The computer program product of Claim 15 wherein if there already exists a sub-folder with the category as a name, a sub-folder is not created and the bookmark to the Web page is moved into the already existed sub-folder.

17. (Previously presented) A computer implemented apparatus for categorizing bookmarked Web pages in a bookmark folder comprising:

means for determining whether a Web page to be bookmarked has been assigned a category on a server;

means for downloading the category if the Web page has been assigned a category;

means for creating a sub-folder in the bookmark folder with the category as a name; and

means for storing a bookmark to the Web page into the sub-folder.

18. (Previously presented) The computer implemented apparatus of Claim 17 further including means for determining whether there already exists a sub-folder with the category as a name before creating the sub-folder.

19. (Previously presented) The computer implemented apparatus of Claim 18 wherein if there already exists a sub-folder with the category as a name, the bookmark to the Web page is stored into the already existed sub-folder and the sub-folder is not created.
20. (Previously presented) The computer implemented apparatus of Claim 17 wherein if the Web page has not been assigned a category, the bookmark to the Web page is stored into a default sub-folder.
21. (Previously presented) The computer implemented apparatus of Claim 20 wherein if the Web page has not been assigned a category, a note is sent to an administrator of the server requesting that the Web page be assigned a category.
22. (Previously presented) The computer implemented apparatus of Claim 21 wherein after the Web page has been assigned a category, the category and the URL of the Web page are downloaded wherein the downloaded category is used as a name to a sub-folder into which the bookmark to the Web page is to be moved and the URL is used to differentiate the Web page from other Web pages that may be in the default sub-folder.
23. (Previously presented) The computer implemented apparatus of Claim 22 further including code means for determining whether there already exists a sub-folder with the category as a name in the bookmark folder before creating the sub-folder.
24. (Previously presented) The computer implemented apparatus of Claim 23 wherein if there already exists a sub-folder with the category as a name, a

sub-folder is not created and the bookmark to the Web page is moved into the already existed sub-folder.

25. (Previously presented) A computer system for categorizing bookmarked Web pages in a bookmark folder comprising:

at least one memory device for storing code data; and

at least one processor for processing the code data to determine whether a Web page to be bookmarked has been assigned a category on a server, to download the category if the Web page has been assigned a category, to create a sub-folder in the bookmark folder with the category as a name and to store a bookmark to the Web page into the sub-folder.

26. (Original) The computer system of Claim 25 wherein the processor processes the code data to further determine whether there already exists a sub-folder with the category as a name before creating the sub-folder.

27. (Original) The computer system of Claim 26 wherein if there already exists a sub-folder with the category as a name, the bookmark to the Web page is stored into the already existed sub-folder and the sub-folder is not created.

28. (Original) The computer system of Claim 25 wherein if the Web page has not been assigned a category, the bookmark to the Web page is stored in a default sub-folder.

29. (Original) The computer system of Claim 28 wherein if the Web page has not been assigned a category, a note is sent to an administrator of the server requesting that the Web page be assigned a category.

30. (Original) The computer system of Claim 29 wherein after the Web page has been assigned a category, the category and the URL of the Web page are downloaded wherein the downloaded category is used as a name to a sub-folder into which the bookmark to the Web page is to be moved and the URL is used to differentiate the Web page from other Web pages that may be in the default sub-folder.
31. (Original) The computer system of Claim 30 wherein the processor processes the code data to further determine whether there already exists a sub-folder with the category as a name in the bookmark folder before creating the sub-folder.
32. (Original) The computer system of Claim 31 wherein if there already exists a sub-folder with the category as a name, a sub-folder is not created and the bookmark to the Web page is moved into the already existed sub-folder.
33. (Previously presented) A computer implemented method of categorizing bookmarked Web pages in a bookmark folder on a local computer system comprising the steps of:

determining whether a Web page is to be bookmarked on the local computer system;

determining, if the Web page is to be bookmarked, whether the Web page has been assigned a category on a remote computer system;

downloading the category if the Web page has been assigned a category;

determining whether the downloaded category already exists as a name of a sub-folder in the bookmark sub-folder on the local computer system;

storing, if the downloaded category already exists as a name of a sub-folder in the bookmark sub-folder on the local computer system, a bookmark to the Web page into the sub-folder;

creating, if the downloaded category does not already exist as a name of a sub-folder in the bookmark sub-folder on the local computer system, a sub-folder in the bookmark folder on the local computer system with the downloaded category as a name for the sub-folder; and

storing the bookmark to the Web page into the created sub-folder.

(ix)

Evidence Appendix

None.

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(x)

Related Proceedings Appendix

None.